

REMARKS

I. Status of the Claims

Claims 1, 3-5, 8, 13-27, and 29-35 are pending. Claims 3-5, 8, 13-27, and 29-35 have been withdrawn from consideration. Thus, claim 1 is pending and under consideration. Claim 1 has been amended to delete recitation of “S(O)₂NR⁶” and “-SO₂-” from the definition of the Z substituent.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

II. The Office Action

A. **Rejection of Claim 1 Under 35 U.S.C. § 102(b)**

Claim 1 is rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by either U.S. Patent No. 5,453,437 (“the ‘437 patent”) or Moreau et al., *Annales Pharmaceutiques Francaises*, 39(3):283-90 (1981). Applicants respectfully traverse this ground for rejection.

According to the Examiner, claim 1 reads on the compound of examples 36 and 37 of the ‘437 patent because those compounds correspond to Applicants’ “Z” moiety of -S(O)₂-NMe₂ and -S(O)₂-NET₂. The Examiner also asserts that Applicants’ claim read on the compound of Moreau et al.

1. **The Claimed Invention is not Anticipated by the Cited Prior Art Because the Claimed Compound, as Amended, Does not Recite an “S(O)₂” Moiety**

Applicants do not acquiesce to the Examiner’s rationale for rejecting the claim. However, for the sole purpose of advancing the prosecution of this case, claim 1 has been amended to delete from the definition of the “Z” moiety structures representing “-S(O)₂NR⁶” and “-SO₂-”.

Neither the ‘437 patent nor Moreau et al. teach or suggest a compound having a pyrrolidine ring with a substituent corresponding to the moiety, Y-Z-R², as required by

Applicants' claim. Accordingly, the claimed invention is not anticipated by the cited prior art. Withdrawal of this ground for rejection is respectfully requested.

B. Rejection of Claim 1 Under 35 U.S.C. § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '437 patent because this reference "teaches a generic group of compounds which embraces applicants' claimed compounds." Office Action at page 3. Applicants respectfully traverse this ground for rejection.

According to the Examiner, "it would have been obvious . . . to select any of the species of the genus taught by the ['437 patent] reference, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole." Office Action at pages 3 and 4.

1. The Claimed Invention is Not Obvious Over the Cited Prior Art Because the Prior Art Does Not Teach or Suggest the Z Substituent Required by Applicants' Claim

The '437 patent does not teach or suggest the "Z" substituent or any of the Z moieties encompassed by Applicants' claim. Specifically, the '437 patent does not teach a "Y-Z-R²" component as presently prescribed. Moreover, the '437 patent does not provide guidance or motivation to one of ordinary skill in the art, at the time the claimed invention was made, suggesting a modification of the compounds taught in the reference to: (a) introduce Applicants' Z substituent into the '437 patent pyrrolidine, or (b) use any one of the three Z moieties presently claimed.

Thus, the '437 patent does not teach or suggest each and every limitation of the claimed invention and, therefore, the claimed invention is patentable over this reference. Withdrawal of this ground for rejection is respectfully requested.

III. Conclusion

As the above-presented amendments and remarks address and overcome all of the rejections presented by the Examiner, withdrawal of the rejections and allowance of the pending claim are respectfully requested. If the Examiner has any questions concerning this application, he or she is requested to contact the undersigned.

Respectfully submitted,

Date July 23, 2003

By Michele M. Simkin

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

Michele M. Simkin
Attorney for Applicant(s)
Registration No. 34,717

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.